

REMARKS

Claims 1-109 are pending after entry of this response. Claim 1 has been allowed. Claims 67-79 and 84-108 have been withdrawn from consideration. Claims 2-66 and 80-83 have been rejected. Claim 109 has been added.

Claim 9 which depends from Claim 6 has been added to include the deposited accession number VKM F-3632D. Support for the accession number is presented as the last paragraph on page 70 (see the Amendment Response filed June 14, 2002). No new matter has been introduced by this claim.

Reconsideration and withdrawal of the below rejections are respectfully requested.

Applicants acknowledge that the rejections stated in the previous Office Action have been withdrawn in favor of the new rejections and new grounds for rejections stated in the instant Office Action.

Applicants thank the Examiner and further acknowledge the withdrawal of the rejection of claims 2-66 under 35 U.S.C. §112, first paragraph for lack of enablement in view of the applicants' arguments filed July 14, 2002.

Specification

Applicants have updated the status of the claim to priority in the first line of the specification.

Response to Rejections under 35 U.S.C. §112, first Paragraph

Claims 2-66 and 80-83 have been rejected under 35 U.S.C. §112, first paragraph as failing to comply with the written description requirement. Applicants respectfully disagree with this rejection.

As previously asserted, the Examiner has misinterpreted the claimed invention. Specifically, the Examiner states that

[t]he claims are drawn to a genus of cellulases, a genus of endoglucanases, and a genus of cellobiohydrolases. The scope of the each genus includes many members with widely differing structural, chemical, and physiochemical properties including widely differing amino acid sequences. Furthermore, each genus is highly variable because a significant number of structural differences between genus members exists.

(Office Action 1/26/06- page 4)

The Examiner further cites the written description requirement pointing to 66 FR 1099, January 5, 2001, as stating that "[o]ne skilled in the art therefore cannot, as one can do with a fully described genus, visualize or recognize the identity of the members of the genus. *Eli Lilly*, 119 F.3d at 1568, 43 USPQ2d at 1406" (Office Action- page 3). Applicants respectfully disagree with the Examiner's contention that the instant specification simply utilizes a name of a genus of compounds.

The instant specification at paragraph [0005] describes cellulases as enzymes that hydrolyze cellulose, specifically at β -1,4-glucan linkages, which includes endoglucanases and cellobiohydrolases. If the Examiner maintains that "cellulase" is a genus, then applicants respectfully direct the Examiner's attention to the "feature commonly possessed by members of the genus that distinguish them from others" is

that all of the cellulases hydrolyze cellulose. Irrespective of the definition of cellulases, applicants assert again that the claims are directed to wild type or mutant *Chrysosporium* fungi and not "mutant cellulases" as the Examiner contends, and that the instant specification supports that the "inventor had possession of the claimed subject matter". The Examiner is well aware that *Ex parte Harvey*, 3 U.S.P.Q.2d 1626 (B.P.A.I. 1986) cites that the:

test for determining compliance with the written description requirement of 35 U.S.C. §112 is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession of the claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language.

Claims 2-66 are directed to compositions obtained from a wild type or mutant fungus. Support for these compositions obtained from wild type or mutant *Chrysosporium* may be found in the instant specification as published at paragraphs [0026] - [0028] and [0051] - [0052], as well as the claims as originally filed. Claims 80-83 are directed to a method for generating mutant strains of *Chrysosporium* and the mutant generated therefrom. Support may be found in the instant specification as published at paragraph [0052] and Example 14. Therefore, the instant specification clearly supports the claimed invention directed to compositions obtained from wild type or mutant *Chrysosporium* and methods of producing the compositions, as well as reasonably conveys to one skilled in the art that the applicants had possession of the claimed invention at the time of filing. For the above reasons, reconsideration and withdrawal of the rejections under 35 U.S.C. §112, first paragraph are respectfully requested.

CONCLUSION

Based on the foregoing amendments and remarks, applicants respectfully request reconsideration and withdrawal of the rejection of claims and allowance of this application.

AUTHORIZATION

The Commissioner is hereby authorized to charge any additional fees which may be required for consideration of this Amendment to Deposit Account No. **13-4500**, Order No. 2976-4055US2.

In the event that an extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. **13-4500**, Order No. 2976-4055US2.

Respectfully submitted,
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